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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,582	12/19/2000	Man C. Niu	13402.00004	6349

34661 7590 06/27/2007
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EXAMINER

BAUM, STUART F

ART UNIT	PAPER NUMBER
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1638

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,582

Applicant(s)

NIU, MAN C.

Examiner

Stuart F. Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 22, 25, 28, 29, 31, 33-36, 38, 40, 42, 43, 45, 47-50, 52, 54, 56, 59, 61, 64 and 66-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/19/2000 & 10/1/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-11,15,22,25,28,29,31,33-36,38,40,42,43,45,47-50,52,54,56,59,61,64 and 66-75.

DETAILED ACTION

1. The amendment filed 3/29/2007 has been entered.
2. Claims 1-11, 15, 22, 25, 28-29, 31, 33-36, 38, 40, 42-43, 45, 47-50, 52, 54, 56, 59, 61, 64, 66-75 are pending.

Applicant added two new claims, both of which are numbered as 74.

The new claims have been renumbered as 74 and 75 according to Rule 1.126.

Claims 74-75 have been newly added and are drawn to the elected invention.

Claims 12-14, 16-21, 23-24, 26-27, 30, 32, 37, 39, 41, 44, 46, 51, 53, 55, 57-58, 60, 62-63, 65 have been canceled.

3. Claims 1-11, 15, 22, 25, 28-29, 31, 33-36, 38, 40, 42-43, 45, 47-50, 52, 54, 56, 59, 61, 64, 66-75 are examined in the present office action.
4. Rejections and objections not set forth below are withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

Claim Objection

6. Claim 34 is objected to for being dependent on a canceled claim.

Scope of Enablement

7. Claim 1-11, 15, 22, 25, 28-29, 31, 34-36, 42-43, 45, 48-50, 52, 54, 56, 59, 61, 64 and 66-73 remain rejected and new claim 74 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for producing a corn plant of variety 27-1 or 85089 expressing soy globulin comprising isolating mRNA from soy cotyledons encoding said

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protein, microinjecting said mRNA into a seed, germinating said seed and growing said transgenic plant from said seed and wherein said plant expresses said soy globulin, does not reasonably provide enablement for a method for producing a transgenic plant which express exogenous proteins, a transgenic plant produced by said method, a method of producing transgenic corn plants expressing an exogenous protein or soy globulin, a transgenic corn plant or kernels produced by said method, said method comprising isolating mRNA from any plant or from soy cotyledons, microinjecting any seed or corn seed with said mRNA under conditions whereby said mRNA enters said seed, and growing said seed to produce a transgenic plant which produces transgenic seed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. This rejection is maintained for the reasons of record set forth in the Official action mailed 9/25/2006. Applicant's arguments filed 3/29/2007 have been fully considered but they are not persuasive.

Applicants state "the references cited by the examiner may not reflect all that the examiner contends" (page 19 or Remarks, bottom paragraph).

The Office contends the state-of-the-art as cited in the previous office action demonstrates unpredictability of the broadly claimed invention and given the breadth of the claims; the lack of guidance and examples; the unpredictability in the art; and the state-of-the-art as discussed previously, undue experimentation would be required to practice the claimed invention, and therefore the invention is not enabled.

Deposit Rejection

8. Claims 33 and 47 remain rejected and new claim 75 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is maintained for the reasons of record set forth in the Official action mailed 9/25/2006. Applicant's arguments filed 3/29/2007 have been fully considered but they are not persuasive.

Applicants request deferral of the requirement for deposit (page 20 of Remarks, 1st paragraph).

The Office contends the deposit rejection is maintained.

9. No claims are allowed.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is 571-272-0792. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Stuart F. Baum Ph.D.
Primary Examiner
Art Unit 1638
June 12, 2007



STUART F BAUM, PH.D.
PRIMARY EXAMINER